

REMARKS

By Office Action mailed August 22, 2005, pending claims 1-66 stand rejected, reconsideration of which is respectfully requested in view of the above amendments and the following remarks. Claims 30-34, 41-49 and 59 have been amended, and claims 35-38 have been cancelled. Claims 1-34 and 39-66 are now pending.

Judicially Created Double Patenting Rejection

The Examiner rejected Claims 1-66 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-62 of U.S. Patent No. 6,696,473. In particular, the Examiner contends that:

*Although the conflicting claims are not identical, they are not patentably distinct from each other because combining the same compounds in both applications with a known drug for the same use is *prima facie* obvious. The compositions are used for essentially the same diseases.*

Applicants submit herewith a *Terminal Disclaimer to Obviate a Double Patenting Rejection over a "Prior" Patent*, which has been signed by the undersigned attorney of record. Applicants respectfully submit that this terminal disclaimer overcomes the rejection of Claims 1-66 under the judicially created doctrine of obviousness-type double patenting in view of U.S. Patent No. 6,696,473, as set forth above.

Rejection of claims 30-34, 37-38, 41-49 and 59 under 35 U.S.C. § 112

The Examiner rejected Claims 30-34, 37-38, 41-49 and 59 under 35 U.S.C. 112, ¶ 1, for non-enablement. In particular, the Examiner contends that:

... the specification, while being enabling for "treating or ameliorating", does not reasonably provide enablement for "preventing or modulating" the various diseases or disorders or symptoms thereof. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The Examiner further notes:

Although this type of claim language has been allowed in the parent case, the office is not rejecting them with the director's approval and signature if required. Basically these claims are considered "reach through" claims and are not sufficiently enabled. The data provided in the instant specification does not support such vast claims to such vast methods of use. Claims especially to "modulating the activity of the nuclear receptor" are no longer permitted because one cannot ascertain the metes and bounds of such a claim. Furthermore, the language of treating, "one or more symptoms of a disease or disorder" or "complications thereof", should be deleted and replaced with conventional language like, "A method for treating atherosclerosis or diabetes, etc.

One of ordinary skill in the art would have to practice unduly to find out which symptoms, which complications, which diseases are treated or ameliorated under the nuclear receptors and more so which diseases are prevented and modulated as claimed. The specification failed to provide sufficient data to support these claims.

It is suggested that the application remove all the vague and speculative language to overcome this rejection.

While not acquiescing to the Examiner's position, Applicants have amended claims 30-34, 41-49 and 59 to remove the term "prevention" and/or phrases similar to "one or more symptoms of a disease or disorder" or "complications thereof". In addition, Applicants have amended the claims to replace "modulating" with "treating or ameliorating" where indicated. Furthermore, Applicants have amended claims 33 and 34 to specifically recite the disease or disorder that is modulated or otherwise affected by nuclear receptor activity or in which nuclear receptor activity is implicated. Support for the amendments to claims 33 and 34 is found in the specification and in cancelled claims 35 and 36 and therefore does not constitute the introduction of new matter.

In view of the afore-mentioned amendments to the claims, Applicants respectfully submit that the rejection of claims 30-34, 41-49 and 59 is hereby overcome. Applicants respectfully reserve the right to pursue excised subject matter in a separate continuation application.

Application No. 10/717,049
Reply to Office Action dated August 22, 2005

Applicants respectfully submit that pending claims 1-34 and 39-66 are clearly allowable. Favorable consideration of these claims and an early Notice of Allowance are earnestly solicited.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,
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Terminal Disclaimer

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